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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/337,546	06/22/1999	SHIGEKI HIROOKA	35.G2410	9128

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/337,546

Applicant(s)

HIROOKA, SHIGEKI

Examiner

George C. Neurauter, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8,10-16,22,24-30,36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,10-16,22,24-30,36 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1, 2, 8, 10-16, 22, 24-30, 36, and 38-40 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 3 May 2006 have been fully considered but they are not persuasive.

The Applicant argues that Tso does not disclose or suggest identifying a data type of each part of a multi-part e-mail while the email is being received by an apparatus and, when it is determined that the data type of a part of the e-mail being received can be processed by the apparatus, storing the part of the e-mail. The Examiner does not agree and maintains the views presented previously.

It is reemphasized that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant argues that a data stream is directed to an appropriate transcode service provider after the data stream is received by a parser of a transcoding server. Tso clearly discloses that the parser and the transcode service provider are embodied within a transcoder that is embodied within the

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transcoding server (see Figures 2 and 3, specifically elements 20, 22, 24, and 34). Therefore, in view of the broadest reasonable interpretation of the claim in accordance with MPEP 2111, an apparatus which receives the data stream is interpreted to be any one of the transcoder, parser, or the transcoding server in which the transcoding server receives that data stream via well known network interfaces, the transcoder receives that data stream from the network interface, and the parser ultimately receives the data stream from the transcoder (see also column 3, lines 8-30). Since the Applicant does not specifically recite which apparatus is receiving the data stream and also does not specifically recite any other apparatus receives the data stream to perform the steps as claimed, the Examiner submits that these multiple interpretations wherein the server which comprises a transcoder which comprises the parser and the transcode service provider wherein the server, the transcoder, the parser, and the transcode service provider all receive the data stream during the operation of the invention are concurrently valid and apply to the claims as recited. Therefore, in view of the combined teachings of Tso and "RFC 1521" as shown previously by the Examiner and the above disclosures within Tso, these references teach the limitations of the claims and the claims are not in condition of allowance.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-2, 8, 10-16, 22, 24-30, 36, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6 421 733 B1 to Tso et al in view of "Request for Comments 1521: MIME (Multipurpose Internet Mail Extensions) Part One" ("RFC 1521").

Regarding claim 1, Tso discloses a processing method for controlling an apparatus, the method comprising the steps of:

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first identifying whether a packet is a multi-part packet based on a header of the packet while the apparatus is receiving the packet; (column 6, line 64-column 7, line 7)

second identifying a data type of each part included in a text of the packet while the apparatus is received the packet, when it is identified in said first identifying step that the packet is a multi-part packet ("MIME"); (column 10, lines 37-49, specifically lines 37-44)

determining whether each part included in the packet can be processed while the apparatus is receiving the packet, by comparing the identified data type of each part with a registered utilizable data type; storing a part that can be processed, included in the packet being received, if it is determined in said determining step that the part can be processed (column 10, lines 37-49, specifically lines 44-49); and

deleting a part that cannot be processed, included in the packet being received, if it is determined in said determining step that the part cannot be processed. (column 2, lines 44-49; column 10, lines 37-49, specifically lines 44-49).

Tso does not expressly disclose wherein the method uses e-mail, however, Tso does disclose that the method uses MIME to perform the invention (column 6, lines 37-41).

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"RFC 1521" discloses that MIME is used in conjunction with e-mail (page 1, Abstract, paragraph beginning "STD 11, RFC 822 defines a message..." and paragraph beginning "In particular, this document...").

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tso to use email as disclosed in "RFC 1521" within the context of the steps disclosed. "RFC 1521" discloses that MIME enables e-mail to be reformatted to allow text and non-text e-mail parts to be sent together without losing any information (page 1, Abstract, paragraph beginning "STD 11, RFC 822 defines a message...", lines 3-5 and paragraph beginning "In particular, this document...") In view of the specific advantages disclosed in "RFC 1521" regarding the use of MIME and wherein both references disclose the use of MIME, one of ordinary skill would have appreciated the specific advantages disclosed in "RFC 1521" and would have found it obvious to modify Tso to accomplish the method disclosed in Tso using e-mail as disclosed in "RFC 1521" based on the specific references to MIME in both references.

Regarding claim 2, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses the method further comprising the step of:

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registering data types that can be processed, in advance, wherein it is determining step that a part can be processed when the identified data type of the part coincides with a registered data type ("predetermined selection criterion"; column 7, line 15-column 8, line 9, specifically column 7, lines 43-54; column 10, lines 37-49, specifically "...interrogating a MIME type in the content-type header record...if parser 22 detects a method for a predetermined selection criterion...").

Regarding claim 8, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a presence of a part that cannot be processed is notified to a user (column 8, line 51-column 9, line 10, specifically column 9, lines 7-10).

Regarding claim 10, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein, when it has been determined that a part cannot be processed, a subsequent process is selectable from a plurality of predetermined processes. (column 7, line 15-column 8, line 9, specifically column 7, lines 43-54; column 10, lines 37-49, specifically lines 44-49)

Regarding claim 11, Tso and "RFC 1521" disclose a method according to claim 1.

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Tso discloses wherein a data type of a part that can be processed is a text. ("content type"; column 10, lines 37-49, specifically lines 37-44)

Regarding claim 12, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a data type of a part that can be processed is an image. ("content type"; column 10, lines 37-49, specifically lines 37-44)

Regarding claim 13, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein identification of a data type is performed by analyzing the received packet. (column 10, lines 37-49, specifically lines 37-44)

Tso does not disclose wherein the method uses e-mail.

Claim 13 is rejected since the motivations regarding the obviousness of claim 1 also apply to this claim.

Regarding claim 14, Tso and "RFC 1521" disclose a method according to claim 1.

Tso discloses wherein a data type of a part is identified in said identifying step according to a reference character string specified based on a position of a predetermined character string in the received email ("content-type header record"; column 10, lines 37-49, specifically lines 37-44).

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Claims 15-16, 22, and 24-28 are rejected since these claims recite an apparatus that contain substantially the same limitations as recited in claims 1-2, 8, and 10-14 respectively.

Claims 29-30, 36, and 38-40 are rejected since these claims recite a computer-readable storage medium storing control software that contain substantially the same limitations as recited in claims 1-2, 8, and 10, and 13-14 respectively.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C.


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Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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